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PATENT

**REMARKS**

Claims 1-22 are pending in the application.

Claims 1-22 have been rejected.

Claims 1 and 12 have been amended as set forth herein. These amendments are respectfully submitted not to add any new matter, and their entry is requested.

Claims 1-22 remain pending in this application.

Reconsideration of the claims is respectfully requested.

**I. CLAIM REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 3-12 and 14-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2002/0057657 to *La Porta, et al.*, hereinafter "La Porta" in view of U.S. Patent No. 2004/0005884 to *Nieminen, et al.*, hereinafter "Nieminen". The Applicant respectfully traverses the rejection.

Claims 2 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over La Porta reference in view of Nieminen reference as applied to claims 1 and 12 above, and further in view of U.S. Patent No. 6,999,766 to *Padovani*, hereinafter "Padovani". The Applicant respectfully traverses the rejection.

In ex parte examination of patent applications, the Patent Office bears the burden of establishing a prima facie case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a prima facie basis to

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deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a prima facie case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

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The Applicant directs the Examiner's attention to independent Claim 1, which recites unique and novel limitations, including those emphasized below:

A wireless network capable of providing a MS-MS packet data call between a source mobile station (MS) and a destination mobile station (MS), said wireless network comprising:

a first base station capable of wirelessly communicating with said source mobile station;

a second base station capable of wirelessly communicating with said destination mobile station;

a mobile switching center capable of connecting said first and second base stations, wherein the mobile switching center is capable of sending an assignment request; and

a local Internet protocol (IP) network capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection, wherein said first base station is capable of receiving a first message from said source mobile station indicating that said source mobile station is to be handed off to a third base station, and wherein said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations.

Amended Claim 1 comprises the limitation of sending an assignment request. This limitation is not taught or suggested by the prior art of record. The sending of an assignment request is discussed in paragraph [0042] of the pending disclosure.

"Meanwhile, MSC 140 also sends Assignment Request message 208 to BS 101 to notify BS 101 that destination MS 113 has been located and the packet data call is being set up. Message 208 contains the IP address of BS 102 on IP network 131. Message 208 also contains the mobile identifier (IMSI or ESN) of MS 113. If not already completed, BS 101 finishes establishing the traffic channel connection to MS 111 (message 209). When this traffic channel is finally set up, BS 101 sends an Assignment Complete message (not shown) to MSC 140 indicating that packet data call connection has been established between BS 101 and MS 111."

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Claim 1 comprises the limitation "a mobile switching center capable of connecting said first and second base stations, wherein the mobile switching center is capable of sending an assignment request." This limitation is not taught or suggested by any of the prior art of record.

The assignment request may comprise an IP address and a mobile identifier. This two part identification is not taught by the prior art of record. *La Porta* only discusses a mobile IP, and *Niemaen* does not cure this deficiency. It is therefore respectfully submitted that none of the cited art of record teaches or suggests sending an assignment request.

In addition, the Applicant respectfully submits that neither *La Porta* nor *Niemenen*, either alone or in combination, discloses, teaches or suggests "a local Internet protocol (IP) network capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection, wherein said first base station is capable of receiving a first message from said source mobile station indicating that said source mobile station is to be handed off to a third base station, and wherein said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations," as recited by independent Claim 1.

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The Examiner has cited no reference to any teaching of an MS-MS packet data call in which data packets are transferred directly between first and second base stations. In fact, the component of *La Porta* cited by the Examiner to show the claimed second base station is a correspondent node that may communicate with a base station through (i) a service provider, (ii) the Internet, (iii) a root router, and (iv) a downstream router. See, *La Porta*, Figure 2. Thus, as the data to and from the correspondent node would be processed through at least these four components, *La Porta* fails to disclose teach or suggest a network transferring data packets directly between the cited base station and the cited correspondent node.

In contrast, independent Claim 1 recites a local IP network “capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection” and “said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations.” By routing the data directly between base stations without additional routing to other components such as a PSDN, for example, the claimed local IP network provides for MS-MS “packet data connections that have low delay and low jitter characteristics.” Present Application, para. 8. The system of *La Porta*, on the other hand, routes data through several additional components and, thus, does not provide this benefit of the claimed invention. Therefore, for at least this reason, a *prima facie* case of obviousness against independent Claim 1 has not been

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presented with reference to the cited art, either alone or in combination. Therefore, the Applicant respectfully submits that this rejection should now be withdrawn.

Similar to independent Claim 1, independent Claim 12 recites "in response to the first message, initiating establishment of a second packet data bearer connection on the local IP network for transferring the data packets associated with the MS-MS packet data call directly between the second and third base stations." Accordingly, for the reasons discussed above in connection with Claim 1, independent Claim 12 is not made obvious by the cited art. Therefore, the Applicant respectfully submits that this rejection should now be withdrawn.

Dependent Claims 2-11, which depend from independent Claim 1, and dependent Claims 13-22, which depend from independent Claim 12, are also not made obvious by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, the Applicant respectfully submits that these rejections should now be withdrawn.

The Applicant also disagrees with the Examiner's rejections of Claims 1-22 based on additional misdescriptions and/or misapplications of *La Porta*, *Nieminen* and *Padovani* to at least some of Claims 1-22. However, the Applicant's arguments regarding those other shortcomings of *La Porta*, *Nieminen* and *Padovani* are moot in view of the Claim 1 arguments above. However, the Applicant reserves the right to dispute in future Office Action responses the appropriateness and the applications of *La Porta*, *Nieminen* and *Padovani* to the claims of the present application, including the right to dispute assertions made by the Examiner in the April 1, 2008 Office Action.

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**CONCLUSION**

As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

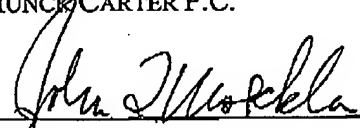
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [jmockler@munckcarter.com](mailto:jmockler@munckcarter.com).

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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